

REMARKS

Applicants appreciate the consideration of the present application afforded by the Examiner. Claims 1-18 were pending prior to the Office Action. Claims 1, 12 and 13 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Election/Restriction

In the Office Action, a restriction requirement has been placed on claims 13-18. The Examiner has indicated that claims 13-18 are allegedly patentably distinct from the apparatus of claims 1-12 based on the limitation in claim 13 that “at least one predetermined accessor is someone other than the first person.” *See Office Action, item 5.*

Applicants respectfully traverse this restriction requirement and submit that the aforementioned limitation in claim 13 is inherently present in claim 1, and therefore cannot be relied upon as a basis for showing that claims 13-18 are allegedly directed to a patentably distinct invention from that of claims 1-12.

First, Applicants note that the preamble of claim 1 clearly recites “An information storing apparatus storing thereon an owner’s personal information”. This recitation clearly refers to information which is the personal information of an owner. The word “owner” is singular. Also, the information is described as being “personal” to an owner. One of ordinary skill in the art, and indeed anyone, would be apprised that the “information” recited in the preamble relates to one owner.

In addition, claim 1 further recites “a personal information storing section storing thereon the owner’s personal information which is to be disclosed to predetermined accessible persons”. As previously discussed, “the owner’s personal information” clearly relates to information for one owner. Thus, since this information is to be disclosed to multiple predetermined accessible *persons*, at least one of the “persons” inherently must be someone other than the owner of the personal information. Accordingly, the Examiner’s reliance upon the limitation “at least one predetermined accessor is someone other than the first person” makes claim 13 patentably distinct from claims 1-12 is without merit as this limitation is inherently present in claim 1.

The instant specification also supports this interpretation of the claims. Paragraph [0002] recites “the present invention relates to an information storing apparatus for setting access level for information for a person other than the owner of the apparatus.” Furthermore, the Examiner has clearly indicated that he is interpreting the claims in this manner. *See Office Action, items 9-11.* The Examiner states that he is interpreting “predetermined accessible persons” as --a plurality of predetermined accessible persons--. As “the owner’s personal information” distinctly refers to the personal information of one owner, and since this information is recited as being disclosed to predetermined accessible persons, one of the predetermined accessible persons must inherently be someone other than the owner.

Applicants further submit that claim 13 is not directed to divergent subject matter at least since Applicants, through this Reply, have amended claims 1 and 12 to explicitly recite “a personal information storing section storing thereon the owner’s personal information which is to be disclosed to a plurality of predetermined accessible persons, wherein at least one of the plurality of predetermined accessible persons is someone other than the owner.”

Applicants submit there is no burden of search presented to the Examiner by claims 13-18. M.P.E.P. § 803 states that “[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner *must* examine them on the merits, even though they include claims to independent or distinct inventions” (emphasis added). In addition, although the Examiner has listed multiple reasons why restriction is allegedly proper (*see Office Action, item 6*), Applicants submit that these reasons provided by the Examiner are mere allegations and are not substantiated by any showing by the Examiner that examination of claims 13-18 are directed to divergent subject matter.

In view of the foregoing, Applicants respectfully request that the Restriction requirement be withdrawn and that claims 13-18 be examined on their merits.

Claim Objections/

Amendments Do Not Alter the Scope of the Claims

Claim 1 is objected to for alleged informalities. Applicants respectfully traverse the Examiner’s objections to claim 1. First, the Examiner’s objection to lines 1-2 is without merit as

the claim as previously amended clearly recites “an owner’s personal information”. Second, the Examiner’s objection to line 5 is without merit as the limitation “predetermined accessible persons” clearly refers to multiple persons. However, in the interest of expeditious prosecution, Applicants have amended claim 1 as suggested by the Examiner.

In addition, as previously discussed Applicants have amended claims 1 and 12 to explicitly recite features inherently present in the scope of the original claims. This amendment is not intended to, and indeed does not, alter the scope of the claims previously presented. For example, the addition of claim language to the preambles of claims 1-12, reciting “an authentication processing and information storing apparatus performing requester authentication processing” is intended to merely clarify the function of the device of the present invention. Applicants note that the claim previously recited, prior to amendment, “a requester authentication section ... performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information”; therefore, the addition to the preamble does not substantively alter the scope of the claim. Furthermore, Applicants have amended the functional limitations of the claims as per the Examiner’s suggestion in the Office Action, items 26-28. Applicants note that the Examiner clearly states that he has previously considered the functional language. *See Office Action, item 26*. Accordingly, Applicants submit that the amendments as suggested by the Examiner do not substantively alter the scope of the claims.

Claim Rejections - 35 U.S.C. §102

Claims 1, 7, 9, 10 and 11 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 6,070,141 to Houvener et al. (“Houvener”). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and traverse the rejection.

In order to establish a *prima facie* case of anticipation under 35 U.S.C. §102, the cited reference must teach or suggest each and every element in the claims. *See M.P.E.P. §2131; M.P.E.P. §706.02*. Accordingly, if the cited reference fails to teach or suggest one or more claimed elements, the rejection is improper and must be withdrawn.

Independent claim 1 recites *inter alia* an authentication processing and information storing apparatus performing requester authentication processing and storing thereon an owner's personal information, comprising: a personal information storing section storing thereon the owner's personal information which is to be disclosed to a plurality of predetermined accessible persons, wherein at least one of the plurality of predetermined accessible persons is someone other than the owner; an accessible person information storing section storing thereon accessible person characteristic information indicating a physical characteristic of each of the plurality of accessible persons; a requester authentication section for receiving requester characteristic information indicating a physical characteristic of a requester who requests the personal information, and for performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information stored on said accessible person information storing section; and an access level setting section for setting an access level, which is a level of the personal information to be disclosed to the requester, when said requester authentication section authenticates the requester as the accessible person.

As previously discussed with respect to the Restriction requirement and the claim objections, Applicants have amended claim 1 merely to explicitly recite a feature already inherent to the scope of the claim, namely that at least one of the plurality of predetermined accessible persons is someone other than the owner of the personal information which is to be disclosed. Applicants respectfully submit that the Houvener reference does not anticipate at least this feature of independent claim 1. Arguments to this effect are largely reproduced herein from Applicants response filed November 28, 2007.

Claim 1 is directed to an apparatus which stores a physical characteristic of each of a plurality of accessible persons who are accessible to one owner's personal information. Owing to this feature, for example, when a requester other than the owner requests access to the owner's personal information, the present invention can perform authentication processing based on characteristic of the accessible person stored in the accessible person information storing section.

In contrast, Houvener is directed to an access database which authenticates an owner for access to his or her own information. Houvener discloses registering a plurality of owners to be identified by storing at least two identification units (data and/or physical characteristics)

corresponding to each user in an identification database. When a particular owner attempts to access his or her information, for example, a user attempting to make a credit card transaction, a first identification unit such as a credit card number is sent to the identification database. The identification database then determines and transmits a second identification unit, such as a picture of the user, to the location of the transaction. Then, a person responsible for positive identification of the user, such as the salesperson performing the transaction, compares the received second identification unit with a corresponding unit physically presented by the user being identified. For instance, the salesperson visually compares the received picture of the user with an ID physically provided by the user to the salesperson. *See Houvener, col. 3, lines 14-62.*

Importantly, although Houvener appears to teach storing characteristics for multiple persons, these characteristics are used only to verify the identification of the multiple persons to provide them with access to their own respective accounts. In contrast, claim 1 expressly recites the features of “a personal information storing section storing thereon the owner’s personal information *which is to be disclosed to a plurality of predetermined accessible persons, wherein at least one of the plurality of predetermined accessible persons is someone other than the owner*”, and “a requester authentication section *for performing authentication processing of the requester using the requester characteristic information and the accessible person characteristic information stored on said accessible person information storing section.*” According to the present invention, multiple accessible persons may be granted at least partial access to an owner’s personal information, provided that they, as requesters, are authenticated by the requester authentication section based on requester characteristic information and stored accessible person characteristic information. Houvener fails to teach or suggest at least this feature of claim 1.

Furthermore, contrary to the Examiner’s assertion, Houvener fails to teach or suggest “an access level setting section for setting an access level, which is the level of the personal information to be disclosed to the requester, when said requester authentication section authenticates the requester as the accessible person,” as recited in claim 1. The Examiner points to controller 7 of Houvener as allegedly teaching this feature. However, close inspection of Houvener reveals no disclosure of controller 7 setting an access level of the personal information

to be disclosed to the requester. Applicants note that the Examiner has largely ignored this deficiency of Houvener, previously discussed by Applicants in their reply filed November 28, 2007. In order to establish a *prima facie* case of anticipation under 35 U.S.C. §102, the cited reference must teach or suggest each and every element in the claims. See *M.P.E.P.* §2131; *M.P.E.P.* §706.02. Applicants submit that Houvener in no way teaches or suggests that controller 7 is operable to or in any way capable of setting an access level of the personal information to be disclosed to the requestor.

Therefore, at least because Houvener fails to teach or suggest each and every claimed element, independent claim 1 is distinguishable from the prior art. Dependent claims 7, 9, 10, and 11 are also distinguishable from the prior art at least due to their dependence from claim 1, directly or indirectly. Accordingly, Applicant respectfully requests that the rejection of claims 1, 7, 9, 10, and 11 under 35 U.S.C. § 102(b) be withdrawn.

Claim Rejections - 35 U.S.C. §103(a)

Claims 2-6 and 12 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Houvener et al. in view of U.S. Patent No. 6,105,027 to Schneider et al. ("Schneider"). Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and traverse the rejection.

For a 35 U.S.C. § 103 rejection to be proper, a *prima facie* case of obviousness must be established. See *M.P.E.P.* 2142. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. See *M.P.E.P.* 2142; *M.P.E.P.* 706.02(j). Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

In this instance, the combination of Houvener and Schneider fails to teach or suggest each and every limitation of claims 2-6, 8, and 12. As demonstrated above, Houvener fails to teach or suggest all of the features of claim 1. Schneider has not been, and indeed cannot be, relied upon to correct at least this deficiency of claim 1. Dependent claims 2-6, 8, and 12 are also distinguishable from the prior art at least due to their dependence from claim 1, directly or indirectly.

Based on the foregoing, Applicants submit that claims 2-6, 8, and 12 are patentable over Houvener in view of Schneider and respectfully request that the rejection of claims 2-6, 8 and 12 under §103(a) be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John R. Sanders Reg. No. 60,166 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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